

REMARKS

Applicant would first like to thank the Examiner for his time and consideration regarding his examination of the application. Preliminarily, Applicant would like to address the Examiner's objections.

The Examiner objected to Applicant's "OFFER TO SURRENDER ORIGINAL PATENT GRANT" for being unsigned. Applicant respectfully submits a signed copy of Applicant's "OFFER TO SURRENDER ORIGINAL PATENT GRANT" included herewith.

The Examiner objected to Applicant's 11/28/03 declaration as failing to identify the residence and mailing address of the inventor. Applicant submits a supplemental declaration herewith to supplement the 11/28/03 declaration. The supplemental declaration provides both the residence and post office addresses.

The Examiner also objected to the declaration under 37 C.F.R. § 1.175(a)(1) and rejected Claims 1-12 under 35 U.S.C. § 251 as being defective for failing to state an error in the claims.

The supplemental reissue declaration submitted herewith now refers to an error regarding Claim 1 of United States Patent No. 6,065,596. Applicant respectfully believes that the supplemental reissue declaration also makes the Examiner's rejections under 35 U.S.C. § 251 moot.

The Examiner objected to Claim 12 because the wording, "within said instrument recess is position therein" does not make grammatical sense. The Examiner suggested to amend "position" into "positioned." Consequently, Claim 12 has been amended according to the Examiner's suggestion.

REJECTIONS UNDER 35 U.S.C. §112

The Examiner rejected Claims 1 and 11 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. The Examiner believes there is no antecedent basis in Claims 1 and 11 for “the arrangement.”

Applicant has amended Claims 1 and 11 accordingly and respectfully believes that the amended claims now overcome the Examiner’s rejection under 35 U.S.C. § 112, second paragraph.

REJECTIONS UNDER 35 U.S.C. §102

On pages 3-5 of the Official Action, the Examiner rejected claims 1-6, 10, and 11 as being anticipated by U.S. Pat. No. 2,522,213 Doniger. The Examiner asserts that Doniger provides a scalpel at knife 11, 13, including a handle/holder 11 and a blade 13, which is attached to the handle. Further, the Examiner alleges that there is provided a container 10 including a recess (unnumbered) in the base of the container, which receives a full scalpel (i.e., handle and blade) shown in Figure 1.

The Examiner further alleges that the container base includes multiple recesses for holding multiple scalpels with the recesses defined between raised elements (unnumbered) in the base. The Examiner argues that each recess includes first and second portions with the first portion holding the blade end and the second portion holding an end of the handle. The Examiner further argues that between the first and second portions is defined a wider recess, which is inherently capable of being used as a finger access recess since this wider recess, is shown to be large enough to place one’s fingers in order to grasp the handle

of the scalpel. The Examiner further believes that this meets Applicant's means-plus-function regarding access means of Claim 4 and the finger access recess of Claim 5.

The Examiner asserts that the scalpel 11, 13 of Doniger is substantially shown as having a major dimension, which is the major dimension of the blade or the diameter of the handle, and a minor dimension, which is the thickness of the blade. The Examiner argues that Figure 1 shows the major dimension being less than the depth of the recess and the minor dimension being less than the depth of the recess. The Examiner further argues that the blade of the scalpel does not face the opening of the recess, and this inherently prevents a person's fingers from being cut by the blade while in the recess.

The Examiner contends that the top faces of the raised elements of Doniger, on each flank of a recess portion opening, are apparently shown to be somewhat horizontal. The Examiner further contends these top faces may be considered to define guide means since one can move/guide a scalpel, which is intended to be inserted, across one of the top faces toward an adjacent one of the recesses, whereupon registry with the recess will permit the scalpel to enter into the recess. The Examiner believes this is not unlike the function claimed for Applicant's guide means since Applicant is not claiming any guiding function, which would distinguish over guiding in a generally horizontal direction. The Examiner argues that, as with Applicant's guide means 20, 21, the movement of the scalpel of Doniger would be across the surface flanking the recess. The Examiner considers the top faces of Doniger to be equivalents to the subject matter disclosed in Applicant's specification as guide means and as referred to in Claim 1 in the means-plus-function, "guide means for guiding a scalpel placed in said container to said scalpel recess."

The Examiner asserts that, regarding the limitation claimed in Claim 1, insofar as claimed, which calls for the scalpel blade to be located in one of the (first and second)

portions irrespective of the position of the scalpel, this limitation does not distinguish the claimed subject matter over Doniger. The Examiner contends that this is because the scalpel 11, 13 of Doniger may be flipped over, about the longitudinal axis of the scalpel, so as to define another position by which the first recess portion (i.e. the one shown on the left) may receive the blade.

Applicant respectfully believes amended Claim 1 is not anticipated by Doniger. The Examiner has attempted to define a single recess in Doniger as including a “socketed cleat” formed to receive a scalpel handle and a “socketed cleat” to receive a scalpel blade as shown in Figure 1 of Doniger. The socketed cleat pairs used for receiving a scalpel should not be considered a single recess, and instead each should at least be considered separate recesses from one another. There is no continuity between a socketed cleat used for receiving a scalpel blade and a corresponding socketed cleat used for receiving a scalpel handle allowing them to be considered a single recess. In fact, the Examiner identifies a “wider recess” between the socketed cleats for the scalpel blades and the socketed cleats for the scalpel handles disconnecting them from one another. Also, the socketed cleats for the scalpel blades are shaped differently than those for the scalpel handles. The socketed cleats for scalpel blades include a flat base and those for the scalpel handles are curved. These are clearly separate recesses, both formed specifically for receiving different portions of a scalpel.

With each socketed cleat defining a separate recess, Doniger fails to contain all of the limitations of amended Claim 1 as required by §102(b). Amended Claim 1 specifically recites “an elongated scalpel recess closed at each end.” Doniger only discloses a plurality of recesses used to receive a single scalpel. No single recess shown in Doniger is

closed at each end. The absence of this limitation in Doniger eliminates this reference from anticipating amended Claim 1.

Doniger also fails to show “guide means for guiding a scalpel placed in said container to said scalpel recess.” The Examiner attempts to identify the “top faces of the raised elements (socketed cleats)” that flank each recess and appear “somewhat horizontal” as defining “guide means.” However, these “somewhat horizontal top faces” do not appear to direct a scalpel toward a recess in any manner. The Examiner argues that scalpel can be moved across a top face toward an adjacent recess to be subsequently entered therein. That argument fails to identify how the top face is providing the guidance. A scalpel disposed on a “top face” is no more so likely to enter one of the socketed cleats adjacent the top face as the scalpel is to enter the other adjacent socketed cleat. The Examiner’s analysis requires that some outside motivation exist to direct a scalpel across a top face and into one of the socketed cleats. The top face does not contribute to the directing of a scalpel, it merely serves as a surface of travel when a scalpel is disposed thereon. Doniger fails to disclose this outside motivation, and therefore fails to show “guide means for guiding a scalpel placed in said container to said scalpel recess.” The absence of this limitation in Doniger alone eliminates the reference from anticipating amended Claim 1.

On page 5 of the Official Action, the Examiner argues that Claim 2, which calls for the guide means to be inclined walls that converge to the opening of the recess, is not considered to distinguish over the side walls of the container base located at opposite ends of the recess. The Examiner contends that Figure 1 of Doniger shows the top surfaces of the container side walls to be inclined. The Examiner further contends that, since the walls are located immediately adjacent the ends of the recesses, the walls may be said to converge toward the recess openings, insofar as claimed by Applicant.

While Applicant respectfully believes that Claim 2 is not anticipated by Doniger because it is directly dependent upon Claim 1, Applicant wishes to address the substance of the Examiner's rejection. For the reasons stated above regarding Claim 1, Applicant respectfully believes that each "socketed cleat" in Doniger serves as a distinct recess, therefore, each recess in Doniger has a side wall adjacent one end and the other end of each "socketed cleat" is adjacent the "wider recess." That point notwithstanding, the Examiner has attempted to make the word "incline" synonymous with "converge." The Examiner believes that because the side walls are slanted, they also converge towards the "socketed cleats". The word "converge" means "to come together from different directions." The side walls of Doniger slope downwardly in the direction of the hinges shown in Figure 1. However, the side walls never come together at any of the socketed cleats. The top surface of each side wall is outside the actual socketed cleats and is not inclined towards the socketed cleat itself, but merely passes by each adjacent one. No convergence is shown by the side walls in Doniger, and therefore cannot anticipate Claim 2.

Applicant respectfully believes that Claims 3-6 are not anticipated by Doniger, due to being either directly or indirectly dependent upon Claim 1.

On page 6 of the Official Action, the Examiner contends that, unlike Applicant's Claims 1-10, Claim 11 does not positively recite its content (the suture holder and needle) as structure but merely as intended use and that the suture holder and needle are not introduced in a structural manner in the claim. The Examiner further contends that that the last paragraph portion of the claim, which refers to "the arrangement," does not overcome this interpretation since there is a lack of antecedent bases for the arrangement, and therefore "arrangement" may be reasonably read as being intended use. The Examiner argues that

regarding Claim 11, there is no requirement that the prior art include a suture needle and holder.

The Examiner alleges that the container of Doniger includes what appears to be a semi-cylindrical recess (i.e., the recess shown holding the end of the handle/holder 11 of the scalpel/knife, however, the recess is inherently capable of receiving a suture needle wherein the point of the needle is pointed downward and therefore away from the opening of the recess, by which a user's finger is prevented from contacting the point of the needle.

The Examiner also alleges that the top faces of the raised elements on each flank of the cylindrical "recess portion opening" are substantially shown to be somewhat horizontal, however, these top faces may be considered to define guide means since one can move/guide a needle holder with needle across one of the top faces toward the recess, whereupon registry with the recess will permit the appropriately sized and shaped holder with needle to enter into the cylindrical recess. The Examiner contends that this is not unlike the function claimed for Applicant's guide means since Applicant is not claiming any guiding function, which would distinguish over guiding in a generally horizontal direction. The Examiner further contends that, as with Applicant's guide means 20, 21, the movement of the needle holder and needle would be across the surface flanking the recess. The Examiner believes that the top faces of Doniger are considered by the examiner to be equivalents to the subject matter disclosed in Applicant's specification as guide means and as referred to in Claim 11 in the means-plus-function, "guide means for guiding a suturing needle held by a suture holder to said needle recess."

Applicant respectfully believes that amended Claim 11 is not anticipated by Doniger. Claim 11 has been amended to recite "[a]n apparatus comprising a suture needle holder, a suturing needle being held thereby, and a container holding said suture needle

holder[.]” Doniger at least does not provide a suturing needle. Further, Applicant respectfully disagrees with the Examiner’s proposition the “top face” serves as guide means since the “top face” does not direct a scalpel of Figure 1 into a particular socketed cleat. The Examiner’s interpretation requires an outside force must be incorporated to direct a scalpel in a particular direction to be subsequently disposed in a recess, as previously discussed regarding Claim 1. For these reasons, Doniger does not anticipate Claim 11.

On pages 7-8 of the Official Action, the Examiner rejected Claims 1 and 4-6 as being anticipated by the published International Application WO 94/08642 to Ross et al. The Examiner contends that the in Ross there is provided a scalpel 15 (shown in Figs. 2-4) and provided a container at secondary tray 13A, which includes a recess (unnumbered) for holding the scalpel. The Examiner believes the recess may be considered to include first and second portions, with the first portion holding the blade end and the second portion holding the handle. The Examiner further believes that beside the recess is defined a wider recess, which is inherently capable of being used as finger access recess since this wider recess is shown to be large enough to place one’s fingers in order to grasp the handle of a scalpel and that this meets Applicant’s means-plus function regarding access means as in Claim 4 and meets the finger access in Claim 5.

The Examiner contends that scalpel 15 is substantially shown as having both a major dimension, which is the dimension parallel with the plane of the container, and a minor dimension, which is the dimension taken vertically and perpendicular to the plane of the container. The Examiner believes that Figure 2 and 3 of Ross show the major dimension to be less than the width of the recess, and the minor dimension to be less than the depth of the recess. The Examiner alleges that, accordingly, the blade of the scalpel does not face the

opening of the recess, and this inherently prevents a person's fingers from being cut by the blade while in the recess.

The Examiner alleges that the top planar surface of container 13A is shown to be somewhat horizontal, but that the top surface may be considered to define guide means since one can move/guide a scalpel (of the type shown) across the top surface toward the recess, whereupon registry with the recess will permit the scalpel to enter in to the recess. The Examiner argues that this is not unlike the function claimed for Applicant's guide means since Applicant is not claiming any guiding function which would distinguish over guiding in a generally horizontal direction. The Examiner further argues that, as with Applicant's guide means, 20, 21, the movement of the scalpel of Ross et al. would be across the planar surface flanking the recess. The Examiner contends that, accordingly, the top surface of Ross is considered to be an equivalent to the subject matter disclosed in Applicant's specification as guide means and as referred to in Claim 1 in the means-plus-function, "guide means for guiding a scalpel placed in said container to said scalpel recess."

The Examiner contends that the limitation claimed in Claim 1, which calls for the scalpel blade to be located in one of the (first and second) portions irrespective of the position of the scalpel, clearly does not distinguish the claimed subject matter over Ross. The Examiner believes that this is because the recess of Ross is rectangular, permitting the scalpel 15 in reverse orientation, in which the handle is closer to the corner of the tray.

Applicant respectfully believes that amended Claim 1 is not anticipated by Ross. The "generally horizontal top planar surface" does not direct a scalpel to towards the recess. Applicant's position is similar to that above regarding the Doniger reference. The scalpel would need an outside directional force applied to it to direct it across the top surface to be placed within the recess. The top planar surface itself provides no directional bias

towards the recess shown containing scalpel 15, only a surface of travel. Ross, therefore, fails to provide a this limitation, and thus does not anticipate Claim 1.

The Applicant respectfully believes Claims 2-6 are allowable over Ross, due to being either directly or indirectly dependent upon Claim 1.

On pages 9-10 of the Official Action, the Examiner rejected Claim 11 as being anticipated by U.S. Patent No. 4,917,243 to Abrams et al. The Examiner alleges that Abrams discloses a container 2, which the reference discloses may be made with an elongated semi-cylindrical shape. The Examiner believes, therefore, that the recess in the container, which is shaped with as the container, will be semi-cylindrical. The Examiner contends that, although the reference of Abrams is intended to be for the disposal of the needle from a hypodermic syringe, the recess is inherently capable of receiving the end of a suture needle holder with a needle therein instead.

The Examiner further contends that, in addition, there is provided a guide means, which may either be the top surface of container 2, or the slit at 3 or the slit at 4, or the slot at 5. This guide means is disclosed for guiding a syringe into the recess so as to avoid accidental pinprick from a used needle; however, this guide means is capable of allowing, instead, the end of an appropriate sized and shaped suture needle holder, with suture needle, to move along its surface into the recess. The Examiner alleges that, accordingly, the guide means is equivalent to Applicant's disclosed guide means with respect to the function claimed by Applicant.

Applicant respectfully believes that amended Claim 11 is not anticipated by Abrams. Claim 11 has been amended to include "a suture needle holder, a suturing needle being held thereby, and a container holding said suture needle holder." Abrams does not teach this limitation, and thus does not anticipate Claim 11.

REJECTIONS UNDER 35 U.S.C. § 103(a)

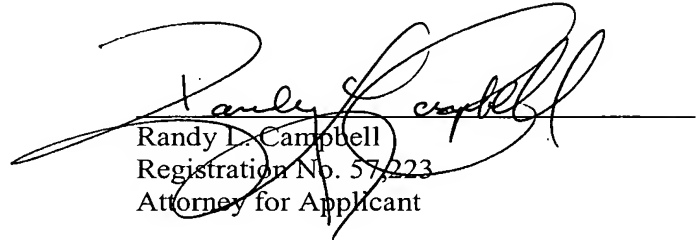
On pages 10-11 of the Official Action, the Examiner rejected Claim 7 over Doniger in view of U.S. Patent No. 5,348,152 to Kiyoshi and over Ross in view of Kiyoshi. On pages 11-12 of the Official Action, the Examiner rejected Claims 8 and 9 over Doniger in view of U.S. Patent No. 5,363,862 to Mercier and over Ross in view of Mercier. On page 12 of the Official Action, the Examiner rejected Claim 10 over Ross.

To establish a *prima facie* case of obviousness, three basic criteria must be met. MPEP § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.*

Applicant respectfully believes that the rejections under § 103(a) are moot in light of the proposed amendments to Claim 1. Applicant has provided an explanation why neither Doniger nor Ross contain all of the limitations of amended Claim 1. These references fail to suggest the limitations as well. Further, the Examiner has not found Doniger or Ross combined with Kiyoshi or Ross combined with Mercier to teach or suggest these absent limitations regarding the claims associated with each combination by the Examiner. Without establishing that these particular combinations of references teach or suggest all of the claim limitations of Claims 7-10, respectively, no *prima facie* case of obviousness can be made. For this reason, Applicant respectfully believes that the Examiner's rejection of Claims 7-10 is moot.

In light of the amendments and remarks, Applicants believe that the application is in condition for allowance and therefore, respectfully request that the Examiner and pass the instant application to issue.

Respectfully submitted,



Randy L. Campbell
Registration No. 57,223
Attorney for Applicant

RLC
Indianapolis, Indiana 46204
317-229-3106
INDS02 YLEE 773659v1